

5 **REMARKS**

Paragraph 3 of the Office Action

Claims 1 and 15 are rejected under 35 USC §112 second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter
10 which applicant regards as the invention.

Claims 1 and 15 have been amended to remove the indefinite term and are now believed to be in compliance with section 112.

Withdrawal of the rejection is respectfully requested by the applicant.

15 **Paragraphs 4-5 of the Office Action**

Claim 1 is rejected under 35 USC §102(b) as being anticipated by Berlin. Claims 2-11 are rejected under 35 U.S.C. §103(a) as being unpatentable over Berlin as applied to claims 1 above.

Claim 1 has been amended to further include a brace. As no brace has been
20 shown in Berlin, it is believed that claim 1 and all claims depending therefrom are allowable with respect to Berlin. The combination of Berlin with May will be addressed later, however it is noted here that Berlin does not discuss a brace for ensuring stability of the legs as applicant's device is defined, but instead Berlin shows a chair having backrest, a seat and a pair of hooks attached thereto. The backrest does not constitute a brace
25 between the legs, but instead includes a pair of side edges that are attachable to the hooks of the Berlin device. For this reason, it is believed that the Examiner has not demonstrated that Berlin includes the elements required for the finding of a 102 or a 103 rejection.

Withdrawal of the rejection is respectfully requested by the applicant.

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Paragraph 6 of the Office Action

Claims 12-15 are rejected under U.S.C. §103(a) as being unpatentable over Berlin as applied to claims 1, 2, 6 and 9-11 and further in view of May.

The applicant has added a support that extends between the hooks. The support
35 serves two purposes. The first is to prevent the hooks from bending outwardly away

5 from each other. The second is to allow screws to be extended through the support and into the vertical surface.

May has been cited for the showing of the support so that a combination may be made between May and Berlin to form applicant's device. However, it is respectfully submitted that this combination is flawed on two grounds. First, the back bar 24 of May
10 is not a support to prevent rotation of the shoulder bars 23 but is the back portion of a loop formed to retain the shoulder bars on a person while they are carrying drums. In particular, the back bar also allows for a mounting place for a cushion 26 to prevent the edges of the shoulder bars 23 from uncomfortably pressing into a user of the May device. As the support of the applicant does not perform either of these functions, the two are not
15 analogous. Additionally, the back bar of may does not have apertures extending therethrough but only bolt receiving holes that allow bolts to be extended through the back bar and into the shoulder bars. Applicant's apertures extend through the support alone, are spaced from the hooks and are not used for attachment to the hooks as applicant's support is integral with and extends between the hooks.

20 The second ground is that there must be motivation in order to form a combination under section 103. Berlin depicts a chair having a pair of hooks attached thereto while May describes a drum holder that is worn on a torso. These arts are not similar and one would not look to the other to retrieve elements unless prodded to do so by a subsequent disclosure. In addition, Berlin intentionally desires the rotation of the
25 hooks about a vertical axis with respect to the backrest. "A pair of hook members 50 and 52 are *pivotaly secured* upon the angle portion of the legs 42 and 44...." Column 2, lines 29-31, emphasis added. A support extending between the hooks, as claimed by applicant, would defeat the purpose of making the hooks pivotal by preventing such pivoting. For this reason, there can be no motivation found within the art cited to
30 combine them. The law regarding obviousness is clear; any modification of the prior art must be suggested or motivated by the prior art:

35 'Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so.' [citation omitted] Although couched in terms of combined teachings found in the prior art, the same inquiry must be carried out in the context of a purported obvious "modification" of the

5 prior art. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.

In re Fritch, 972 F.2d 1260; 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992), (in part quoting from ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577; 221
10 USPQ 929, 933 (Fed. Cir. 1984)).

Since the combination was made using two devices, which do not have similar uses or constructions, and whose combination would lead to the reduction of benefits each enjoys, it is respectfully submitted that the Examiner has used hindsight reconstruction to find the proposed combination.

15 [T]he Examiner relied upon hindsight to arrive at the determination of obviousness. It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that
20 '[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.' [citations omitted]

In re Fritch, 972 F.2d 1260; 23 USPQ2d 1780, 1784 (Fed. Cir. 1992), (in part quoting from In re Fine, 837 F.2d 1071, 1075; 5 USPQ2d 1596, 1600 (Fed. Cir. 1988)).

For these reasons, the applicant respectfully requests withdrawal of the rejection.
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New Claims

New claims 16 and 17 more fully define the support and the coupler in general. It is noted that while May might show apertures in the back bar 24, those apertures are not open as they are used for receiving bolts that attach the back bar 24 to the shoulder bars
30 23. Thus, it is submitted that all references to apertures in the support are patentably definable with respect to May and that May actually does not show apertures as defined by applicant.

As to new claims 18-21, it is believed that neither May nor Berlin contemplated the use of their devices for holding tissue boxes. As such use has been presented in the
35 claims and specification as filed, it is believed that no new matter or arguments have been added as a result of these claims.

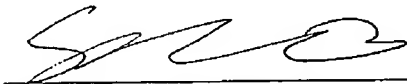
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CONCLUSION

10 In light of the foregoing amendments and remarks, early consideration and
allowance of this application are most courteously solicited.

Respectfully submitted,

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